

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No. 09/843,771
Docket No. Q63730

REMARKS

Claims 1-4, 6-9, and 11-24 are all the claims pending in the application. Claims 5 and 10 have been canceled. New claims 16-24 have been added. Claims 1, 6, 7, 9, 12, 13, 15, and 22 are independent claims.

Specification and Claim Objections

The Examiner has objected to the specification and claims, alleging minor informalities. Applicant has amended the specification and claims accordingly and requests the Examiner to withdraw the objections.

Claim Rejections Under 35 U.S.C. § 112

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. The Examiner alleges that the phrase “voice message” is unclear. Although Applicant believes that claim 5 in its original form is clear, as a path of least resistance, Applicant has made cosmetic changes to claim 1 (which includes the recitations of original claim 5, now canceled). Because the scope of subject matter claimed is unchanged, no estoppel is inflicted.

Claims 1, 6, 7, and 15 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification such a way as to enable one skilled in the art to make and/or use the invention. The Examiner alleges that the phrase “transferring said converted message to said CAS” is not disclosed in the specification.

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Applicant respectfully traverses this rejection. As an initial matter, the Examiner does not contend that one skilled in the art would not know how to make or use the claimed invention, but instead alleges that certain features of the original claims are not disclosed by the specification. Therefore, it appears that the Examiner is confusing §112's enablement requirement with §112's written description requirement. *See* MPEP §2161-2165.

With respect to §112's written description requirement, there is a strong presumption that the original claims, such as those rejected, provide an adequate written description. In this case, one of ordinary skill in the art would recognize the claimed invention upon reading these claims.

Regardless, in addition to the language of the original claims, page 12, line 18- page 13, line 10 of the original specification discusses a non-limiting embodiment in which a non-voice format is transferred to the call answering system. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection.

Claim Rejections Under 35 U.S.C. § 102 and §103

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Agraharam et al. (US 6,483,899). Claims 6, 7, 9, 12, 13, 14, and 15 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Skinner et al. (US 6,529,737). Claim 4 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Agraharam in view of Fortman (US 6,203,192). Claim 5 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Agraharam in view of Skinner. Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Skinner in view of Casellini (US

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6,404,860). Claim 11 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Skinner and Casellini, as applied to claim 10, and further in view of Groner (US 6,507,643).

Claims 1-4

With respect to independent claim 1 (original claim 5), Applicant respectfully requests the Examiner to withdraw the rejection at least because the combination of Agraharam and Skinner does not teach or suggest all of the claim recitations. For example, the combination of Agraharam and Skinner does not teach or suggest the claimed system that enables replying to the converted voice message by a voice message reply and sends a voice message to a called party in which *the voice message reply is converted to a non-voice format*, and transferred in said non-voice format.

The Examiner acknowledges that Agraharam does not teach a “reply to the voice message.” Therefore, the Examiner looks to Skinner in an attempt to make up for this deficiency.

However, Skinner does not teach a system in which there is a reply to the converted voice message that is converted to a non-voice format. Instead, Skinner teaches a system in which a Short Message Service uses voice recognition to convert a caller’s voice message into a SMS message. Skinner at 7:62-65. Although the subscriber may respond to the message by placing a separate phone call, there is no teaching or suggestion that this reply is *converted to a non-voice format*. Skinner at 3:5-7.

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As such, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1. Furthermore, Applicant respectfully requests the Examiner to withdraw the rejection of claims 2-4 at least because of their dependency from claim 1.

Claims 6-15

Independent claim 6 has been amended to further define the invention. The amendments to claim 6 are fully supported by the original specification at least by the discussion of a non-limiting embodiment on page 13, line 13- page 14, line 13.

With respect to independent claim 6, Applicant respectfully requests the Examiner to withdraw the rejection at least because the combination of Skinner, Casellini, and Groner does not teach or suggest all of the claim recitations. For example, the combination does not teach or suggest the claimed system in which the Call Answering System (CAS) provides a text message *that includes a pre-prepared message selected from a plurality of available pre-prepared messages and the converted text.*

For example, Casellini merely teaches a system in which a called part may respond to a call using a pre-prepared voice message or a text-to speech message. Casellini at Fig. 6.

Furthermore, Groner merely teaches a system in which portions of a text message that are sent to the called party are automatically generated by the dialog manager 104. Groner at 7:41-45 & Figs. 6 and 7. There is no teaching or suggestion that the automatically generated portions are selected from a plurality of available messages.

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As such, Applicant respectfully requests the Examiner to withdraw the rejection of claim 6. In addition, Applicant respectfully requests the Examiner to withdraw the rejection of additional independent claims 7, 9, 12, 13, and 15 for at least the reasons discussed above with respect to claim 6. Applicant also respectfully requests the Examiner to withdraw the rejection of claims 11 and 14 at least because of their dependency from claims 9 and 13, respectively.

New Claims

Applicants respectfully request the Examiner to withdraw the rejection of new dependent claims 16-21 at least because of their dependency.

New claims 22 and 23 have been added. New claims 22 and 23 are fully supported by the original specification at least by FIG. 3 and the non-limiting embodiment discussed on page 17. With respect to new independent claim 22, Applicant submits that the claim is allowable at least because none of the cited references teaches or suggests a system for enabling a calling party to send at least one text message to a called party having an Interactive Voice Response System for allowing the calling party to select a pre-prepared message from a plurality of pre-prepared messages, and a call answering system that provides a text message including the pre-prepared message to the called party.

For example, Casellini merely allows *the called party* to answer using pre-recorded messages. Casellini at Fig.6. In addition, if a called party selects a pre-recorded message, then that message is “read” to the calling party by the system. Casellini at 4:42-5:25.

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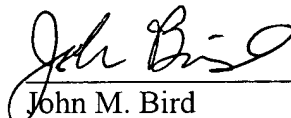
Applicants also submit that claims 23 and 24 are allowable at least because of their dependency from claim 22.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



John M. Bird
Registration No. 46,027

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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